

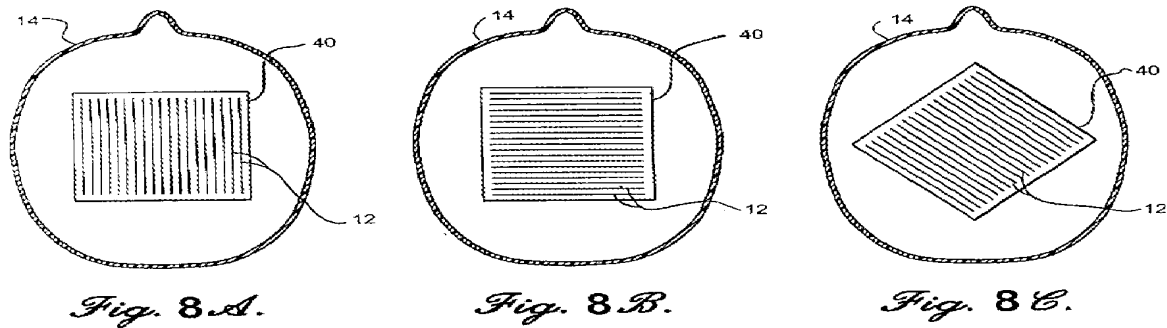
REMARKS

Claims 1, 2, 5, 6, and 15-18 are currently pending, with Claims 1, 15, and 18 being independent.

Claims 1, 2, 5, 6, and 15-18 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Robar et al. (U.S. 6,826,313) in view of Yoshida (U.S. 6,178,005), Anderson (U.S. 6,563,535) and Parulski et al. (U.S. 5,414,811). At least for the following reasons, this rejection is respectfully traversed.

Claims 1 recites a method of reading a plurality of film originals, each being mounted with a slide mount, which are placed on an original support of an image reading apparatus in a plurality of orientations. The method includes, *inter alia*, an image reading step and a display orientation setting step. The image reading step includes reading each of a plurality of film originals placed on the original support in a mixed manner with a landscape orientation and a portrait orientation. The display orientation setting step sets a display orientation for all of a plurality of generated image signals, by one setting.

The Office Action contends, on page 3, that Robar et al. discloses a single set of films having films in a landscape orientation and a portrait orientation, and that a film cassette comprising such films will be read in a mixed manner with a landscape orientation and a portrait orientation. To support this contention the Office Action cites to Figure 8 and column 9, lines 35-45. Applicant respectfully disagrees. For the Examiner's convenience, a copy of Figures 8A-8C is reproduced below.



As discussed in column 9 of Robar et al., Figures 8A-8C show a phantom 14 with a film cassette 40 mounted at a known location inside the phantom 14. Inside the film cassette 40 is a set of films 12. Figures 8A-8C show different orientations of the cassette 40 inside the phantom. A set of films corresponding to each orientation is exposed and then separately digitized in step 110 of Figure 1. Thus, contrary to the Office Action's contention, Figures 8A-8C disclose different orientations of the cassette inside the phantom 14, but cannot be said to disclose reading each of a plurality of film originals placed on an original support in a mixed manner with a landscape orientation and a portrait orientation, as recited in Claim 1. Furthermore, Applicant submits that none of the secondary references can be said to remedy the deficiencies of Robar et al.

Claim 15 relates to a system for reading a plurality of film originals. The system includes, *inter alia*, an image reader for reading each of the plurality of film originals placed on the original support in a mixed manner with a landscape orientation and a portrait orientation. The Office Action relies on Robar et al. to allegedly disclose the above feature of Claim 15. (Office Action, p. 4). In light of the above discussion of Robar et al., however, Applicant submits that Robar et al. does not disclose, at least, the above recited feature of Claim 15.

Furthermore, Applicant submits that none of the secondary references can be said to remedy the deficiencies of Robar et al.

Claim 18 relates to a method of reading a plurality of originals placed on an original support and displaying the plurality of originals. The method includes, *inter alia*, an image reading step of reading each of the images of the plurality of originals placed on the original support in a mixed manner with a landscape orientation and a portrait orientation. The Office Action relies on Robar et al. to allegedly disclose the above feature of Claim 18. (Office Action, p. 11). In light of the above discussion of Robar et al., however, Applicant submits that Robar et al. does not disclose, at least, the above recited feature of Claim 18. Furthermore, Applicant submits that none of the secondary references can be said to remedy the deficiencies of Robar et al.

Claims 2, 5, 6, and 16 depend from Claim 1. Claim 17 depends from Claim 15. Accordingly, at least for the reasons discussed above in regard to Claims 1 and 15, Applicant submits that the proposed combination of the applied references, even if proper, does not disclose features recited in Claims 2, 5, 6, 16, and 17.

At least for the reasons discussed above, the outstanding rejection under 35 U.S.C. § 103(a) should be withdrawn. Applicant also submits, however, that the proposed combination of the applied references is improper.

The Office Action contends that it would be obvious to modify Robar et al. so that landscape placement of film images are always generated and displayed, because “it provides a standardized format of orientation placement that is automatically and conveniently reproduced.” Applicant respectfully disagrees.

Robar et al. already discloses a method of automatically reorienting film images so that the film images are in the correct orientation, i.e., the fiducial marks are aligned. (*see* Figures 7A-7D; column 7, lines 1-9). Thus, contrary to the Office Action's assertions, no additional benefit is gained by a landscape placement of film images. In fact, Applicant submits that the proposed modification renders Robar et al. unfit for its intended purpose.

As is clear from Figures 8A-8C, the films 12 in the cassette 40 are positioned at discrete locations with respect to the phantom 14. Robar et al. makes clear that the fiducial marks should be applied before the films 12 are removed from the cassette 40, so that the set of films 12 cannot be mixed up in order or orientation before the fiducial marks are applied. (Robar et al., column 9, lines 22-27, emphasis added). The rationale for this is also clear: the order and orientation of the films in the cassette are important because they correspond to a dosage of radiation received at a particular point. Thus, the orientation of the films 12 in the cassette 14 must be preserved. Performing orientation and rotation of the films such that they are in landscape placement – as the Office Action suggests – rather than according to the fiducial marks, would result in inaccurate data about a radiation dose at a particular point, thus rendering Robar et al. unfit for its intended purpose. Applicant respectfully points out that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” (MPEP § 2143.01).

The Office Action also contends that it would be obvious to modify Robar et al. to provide automatic processing and correct display of captured images regardless of the orientation the images were originally captured in, as allegedly disclosed in Anderson. (Office Action, pp. 7-8). As made clear above though, the films in Robar et al. have a singular set orientation when

they are exposed to the radiation, namely their placement within the cassette 14. Accordingly, even assuming, *arguendo*, that the Office Action's interpretation of Anderson is correct - there is no rationale for combining a method of reorienting images to a specific orientation, regardless of the orientation in which they were captured, with a system where the films are all in the same orientation when they are exposed.

At least for the reasons discussed above, Applicant submits that the one of ordinary skill in the art at the time of the invention would not have modified Robar et al. as the Office Action suggests. Rather, Applicant submits that the proposed combination of the applied references is based on impermissible hindsight reasoning, and therefore the proposed combination is improper.

In light of the above, reconsideration and withdrawal of the outstanding rejection under 35 U.S.C. § 103(a) is respectfully requested.

Applicant submits that the claims presented herein are patentable over the applied references. The dependent claims set forth additional features of the Applicant's invention. Independent consideration of the dependent claims is respectfully requested. Applicant submits that the subject application is in condition for allowance, and such action is respectfully requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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